PATENT

REMARKS

Reconsideration of the rejections set forth in the Office action dated 6/3/2005 is respectfully requested under the provisions of 37 CFR §1.111(b).

Applicant has included a petition for a two month extension of time and has authorized the corresponding fee.

Claims 1-29 are pending.

Claims 1-29 stand rejected.

Claim 12 was objected to.

Claims 3-4, 7, 15-16, and 19-29 are canceled.

New claim 30 was added.

Claims 2 and 6 were amended to change "third party" to "third-party" so that that phrase is consistent with the phrase used in the specification. These amendments are completely grammatical and have no patentable affect.

Independent Claims 1, 5, 9 and 17 have been amended to include limitations directed towards selecting a location on the tamper-proof document to place the information, selecting a level of access for the encoded information, processing the encoded information responsive to the selected level of access, and printing the encoded information as an area of glyph marks at the location (for support see Figs. 1, 11, 12 and paragraphs [045]-[048], [026]-[029] et al).

Previous claim 16 has been moved to new claim 30 and now depends from claim 17.

I. Approval of Drawings Submitted April 2002

The Examiner has approved the informal drawings that were submitted on with the application as filed. A set of formal drawings were submitted and with the Reply to

PATENT

the Notice of Missing Parts and received by the PTO on April 8, 2002. Applicant requests the Examiner to approve these drawings.

II. Objected-to Claim 12

Claim 12 was amended to address the objection by making it more clear that the viewport is part of a lens apparatus as is described at least at paragraphs [041] – [044] and [049] – [055]. Applicant believes this amendment to Claim 12 addresses the Examiner's concern because the lens apparatus includes a computer that processes the encoded information and generates the decoded information for display through the lens. Thus, applicant request the Examiner to withdraw this objection.

III. Rejections under 35 USC § 101

Claims 19-29 have been canceled, thus this rejection is moot.

IV. Rejections under 35 USC § 102(b)

Claims 1-2, 4-11, 15-1 8, and 19-29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US. Patent 5,490,217).

A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art.

Applicant has amended independent claims 1, 5, 9, and 17 to include limitations directed towards selecting a location on the tamper-proof document to place the encoded information, selecting a level of access for the encoded information, processing the encoded information responsive to the selected level of access, and printing the encoded information as an area of glyph marks at the location specified on the tamper-proof document.

Currently amended claim 5 is illustrative of these limitations and is:

> A method for creating a tamper-proof document, comprising:
> digitally encoding a user-inputted portion of the document as encoded information;
> selecting a location on the tamper-proof document to place the encoded information;

PATENT

> selecting a level of access for the encoded information;
> processing, responsive to selecting the level of access, the encoded
> information; and
> printing the tamper-proof document including the encoded
> information as an area of glyph marks at the location.

Wang does not anticipate currently amended claim 5 because Wang does not teach:

- "selecting a location on the tamper-proof document to place the encoded information" – While Wang shows that the 2-D barcode is placed in different positions for different documents Wang does not teach how those positions were selected as does the instant invention (see Fig. 12, 1220; and paragraph [046]).

- "selecting a level of access for the encoded information; processing, responsive to selecting the level of access, the encoded information" – While Wang mentions encryption (Col. 5, lines 22-29), it does not teach levels of access as does the instant application (see Fig. 12, 1230; and paragraph [047]).

- "printing the tamper-proof document including the encoded information as an area of glyph marks at the location" – While Wang teaches printing documents using a 2D barcode for encoded information, Wang does not teach printing documents where the encoded information is printed as an area of glyph marks at the specified location (see Fig. 12, 1240; Fig 1; and paragraphs [026]-[028].

Hence Wang does not anticipate **currently amended claim 5**. For similar reasons, Wang does not anticipate **currently amended claims 1, 9, and 17** and applicant believes these currently amended claims are not anticipated by Wang. **Claims 2, 6, 8, 10-14, 18, and 30** directly or indirectly depend from and further limit their respective independent claims and so are also not anticipated.

PATENT

V. Rejections under 35 USC §103(a)

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US. Patent 5,490,217) as applied to claim 1, and further in view of Cummings et al. (U.S. Patent 6,869,015).

Claim 3 has been canceled thus, this rejection is moot.

Claims 12-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US. Patent 5,490,217) as applied to claim 9 above, and further in view of Mayer, Jr. et al. (U.S. Patent 6,869,015).

Applicant first notes that the above rejection cited Mayer as U.S. Patent 6,869,015 instead of U.S. Patent 4,202,626. Applicant believes that the Examiner intended to cite Mayer and that the inconsistent patent number was an oversight.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Currently amended **claim 9** is directed to:

A method for ensuring that a document has not been altered, comprising:
      digitally encoding a user-inputted portion of the document as encoded information;
      selecting a location on the tamper-proof document to place the encoded information;
      selecting a level of access for the encoded information;
      processing, responsive to selecting the level of access, the encoded information;
      printing the tamper-proof document including the encoded information as an area of glyph marks at the location.
      decoding the encoded information as decoded information;
      comparing the decoded information with the user-inputted portion; and
      identifying the document as altered, if the decoded information is not identical to the user-inputted portion.

PATENT

As previously discussed, Wang does not teach selecting a level of access, or printing the tamper-proof document including the encoded information as an area of glyph marks at the location. Furthermore, nothing in Wang would suggest these limitations to one skilled in the art. Thus, **currently amended claim 9** is patentable over Wang. Claims 12-14 directly, or through intervening claims, depend on and further limit currently amended claim 9. Thus, **currently amended claim 12, and original claims 13 and 14** are patentable.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

The undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

DANIEL B. CURTIS
Attorney for Applicants
Reg. No. 39,159
(650) 812-4259
dbcurtis@parc.com